SUPREME COURT

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In the Supreme Court of the United States

OCTOBER TERM, 1957.

No. 533.

PARKS-CRAMER COMPANY,
a Corporation of MASSACHUSETTS,
Petitioner,

vs.

THE AMERICAN MONORAIL COMPANY,
a Corporation of OHIO,
Respondent.

BRIEF OF RESPONDENT
In Opposition to Petition for Writ of Certiorari.

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STATEMENT OF THE CASE.

This is a suit, in the usual form, for alleged infringement of one claim of a patent containing six claims and relating to a traveling blower for removing accumulations of lint from textile machines, particularly spinning machines.

The District Court, in a non-jury action, held the claim in suit valid and infringed (147 F. Supp. 218). The Court of Appeals for the Fourth Circuit held that the claim in suit was invalid for lack of invention and reversed the decree of the District Court (245 Fed. (2) 739).

The decision sought to be reviewed is manifestly right. It is not in conflict with any decision on the patent in any other Circuit. It involves nothing more than the reversal

of the decision of the District Court on a question of law. It is based on controlling principles of law which are well established in this Court.

There is no question of general or public interest or importance involved in this case. The patent is of interest only to the parties to this suit. No showing has been, or can be, made that there can be no litigation on this patent in any other Court of Appeals.

The Court of Appeals did not decide an important question of Federal law—the issue decided was whether the patent was valid. The Court of Appeals did not depart from the accepted and usual course of judicial proceedings. There was no conflicting testimony, the patented device was simple, and readily understood by laymen and much of the evidence was physical and documentary and the Court of Appeals saw and considered both. Thus the Court of Appeals was as able to decide the issues as the District Court and, moreover, has had extensive experience in deciding patent cases.

The second question raised by Petitioner, i.e., as to whether 35 U. S. C. 103 was followed, is raised here for the first time in this case. It was not raised by Petitioner in either of the lower Courts. Since it is a law question, it is now too late to raise it.

This suit is merely a vain effort to stretch a patent, after seven years of proven commercial failure of the device disclosed therein, to cover a device which was different in structure, operation and results and met with success.

There is no reason for granting a Writ of Certiorari in this case.

THE PATENT IN SUIT.

Petitioner's description (3-5) * of the history of the cleaning of spinning frames is generally correct but the statements (6) as to the problem allegedly solved by the patentee Holtzclaw and the means by which he solved it are not entirely correct. Furthermore, the discussions of the proofs (8-10) are quite optimistic, to say the least.

The patent in suit (91a-97a) does not disclose any concept of, or apparatus for, using "air outlets (cuffs, nozzles or sleeves) of appropriate size and shape to deliver air currents of the right volumes and velocities at the right places and in the right directions," (6) for a thorough and complete cleaning of a spinning machine.

The patent in suit describes the alleged invention, the problem which it sought to solve and the solution with reference to certain prior cleaner patents identified in the specification. It claims merely to have improved the apparatus of those patents.

It states the alleged invention as follows:

> "* * * the present invention relates only to improvements in the mechanism for directing the blasts of air delivered by the fan." (Col. 1, 41-42.)

That "mechanism" was nozzles "of highly flexible material" (96a, Col. 1, l. 35).

The patent states the alleged problem as follows:

> "For example, in the use of the traveling cleaner for cleaning a spinning frame *blasts* ** *of air are not fully effective in preventing accumulation of lint and the like upon the lower face of the creel board and upon the spools of roving located closely therebeneath and the deposition or accumulation of bunches of lint*

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* This symbol ( ) designates pages in the petition.

** Emphasis throughout is ours.

upon the roving running from said spools." (Col. 2, ll. 3-10.)

The patent states the alleged solution as follows:

"The nozzle 19, which conducts the blast of air transversely of the machines, is of highly flexible material and extends well below the end of the nozzle 18 and is provided with an inwardly curved and preferably tapering end portion which is positioned at such predetermined height as *to direct the air inwardly beneath the creel board 4 thereby to prevent accumulation of lint upon the under face of the creel board* or upon the spool of roving 5 and the strand 20 leading therefrom through the usual guide eye 21 and drawing mechanism 22 to the ring rail 23 having the usual ring and traveler for spinning and winding the strand 20 upon the bobbin 24." (96a, Col. 1, ll. 42-55.)

* * * * *

"*The cuff may be of any desired length to position its outlet* at such predetermined height *as to direct the current of air transversely* across the machine *closely beneath the creel board of the spinning frame*, * * *." (96a, Col. 1, ll. 64-69.)

Thus it is seen that the apparatus disclosed in the patent was intended, and was useable, solely for removing lint a little more efficiently than formerly from the creel portion of a spinning machine and that apparatus amounted merely to the substitution of two flexible cuffs for two metal cuffs of the cleaner of the Hodge Patents Nos. 2,047,558 (103a) or 2,184,880 (139a) (9a, 25a, 29a). Like the apparatus of those patents, the apparatus disclosed in the patent in suit could not clean the underframe of a spinning machine.

The truth of the matter is that this alleged problem was quite unimportant to the industry and the solution

was of so little utility that its value could not be measured in dollars and cents. (34a, 36a.)

QUESTIONS PRESENTED.

(1)* Did the Court of Appeals err in reversing the trial Court and holding that the patent in suit was invalid for lack of invention in view of certain Findings of Fact by the District Court?

Long Felt Need: There is no proof in the record that there was any demand for better cleaning between the top and middle creel boards than that afforded by the Hodge type cleaners.

There is no proof in the record that any user of a traveling creel cleaner felt any need for, or demanded, a better creel cleaner. There is no proof in the record that anyone prior to Holtzclaw ever tried and failed satisfactorily to clean between the upper and middle creel boards with streams of air.

The claim (8) that there was a long felt need for the alleged invention of the patent in suit rests solely on the testimony of two witnesses (7x, 37x) and on prior patents. Both witnesses correctly testified that the prior Hodge type cleaner did not do a complete job of automatic cleaning for that cleaner was incapable of cleaning the underframe and was capable of cleaning only the creel of a spinning machine. The first witness testified that efforts made prior to Holtzclaw to improve the quality of the cleaning included making the air outlets adjustable and installing vanes in some of the outlets. These expedients were for the purpose of improving the cleaning of the creel. The prior patents relied on were for devices to clean only the

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* We shall discuss the questions stated on pages 2 and 3 of the petition rather than the variations stated on pages 8, 13 and 21.

creel of a spinning machine. Holtzclaw disclosed only the cleaning of a creel.

Commercial Success: There is no proof of prompt and large-scale acceptance of the apparatus disclosed in the Holtzclaw patent. On the contrary, the proof is that plaintiff never built any traveling cleaner like that shown in the patent. The flexible cuffs shown in the patent constituted the "best mode contemplated by the inventor of carrying out his invention." (35 U. S. C. 112). They were sold for substitution for rigid nozzles of the Hodge cleaners disclosed in patent No. 2,184,880, but the number so sold was so small that plaintiff gave no figures as to the sales (25a, 26a, 29a). The only proof as to the utility of those cuffs was the admission of one of Petitioner's witnesses that there was no noticeable difference in the labor of cleaning a spinning machine when using the device of the patent in suit or the cleaner of Hodge patent No. 2,184,880 (34a, 36a).

The commercial success enjoyed by the apparatus of Plaintiff's Exhibit 16 is not traceable to the patent in suit. The apparatus of that exhibit is quite different structurally from the apparatus disclosed in the patent and by reason thereof was able to remove lint from within the underframe, a function which could not be performed by the device disclosed in the patent or in any of the prior art. Since the device of Exhibit 16 used the short curved cuffs of the Holtzclaw patent which the proof showed had no commercial success, it follows that any commercial success enjoyed by the apparatus of Exhibit 16 must be traceable to something other than what was disclosed in the patent in suit. That additional something was the long, vertical tubes which extended down to below the creel and directed air streams into the underframe to remove ac-

cumulations of lint in that area. This was something not suggested by or disclosed in the patent in suit.

Obviousness: The identified patents (10) to Hodge, Smith, Moore and Miller & Becker do not establish lack of obviousness of the alleged Holtzclaw invention.

Hodge and Smith were fellow employees with Holtzclaw and each one was promoting his particular form of creel cleaner. Hodge made several minor structural changes in his cleaner and Holtzclaw supplied a different but also minor structural change to the Hodge cleaner.

The Moore patent was for the totally different purpose of removing lint from wall surfaces of textile mill rooms. It could not be used to clean a spinning machine. Moreover, the Moore application was not filed until April 16, 1948, over four months after Holtzclaw filed his application and, of course, a much longer time after he made his alleged invention.

The Miller & Becker patent was for cleaning only the underframe of a spinning machine—not for cleaning the creel. It was the first successful underframe cleaner (21a). Moreover, the application for this patent was filed on January 10, 1949, some thirteen months after Holtzclaw filed and an even longer time after he made his alleged invention.

The Statute (35 U. S. C. 103) fixes the time when the invention was made as the time when obviousness is to be considered. Both of the Moore and the Miller & Becker patents were filed long after Holtzclaw's date of alleged invention.

Thus the Moore and the Miller & Becker patents being for totally different devices and purposes and being too late to come within 35 U. S. C. 103 are of no avail as regards showing lack of obviousness of the alleged invention of the patent in suit.

(2) Did the Court of Appeals err in applying an improper test of what constitutes patentable invention in view of the enactment of Section 103 of Title 35 of the U. S. Code?

Neither in the District Court nor in its Petition for Rehearing in the Court of Appeals did Petitioner contend that error had been committed in not following 35 U. S. C. 103. Indeed, Petitioner did not so much as mention that Statute in its brief in either of those Courts. Neither Court passed on any such contention. Since the alleged error raises a question of law which is raised for the first time in the Petition, it is too late for this Court to consider. *Virtue v. Creamery Package Manufacturing Company and Owatonna Company*, 227 U. S. 8, 38; *Lyons v. United States*, 123 Fed. (2) 507, 508 (CA 6).

The grounds (14) on which it is claimed that the Court of Appeals failed to apply Section 103 of the Statute have already been shown to be non-existent or of insignificant force. There was no proof of extent of need of the alleged invention, no proof of prior efforts and failure to supply that need, no acceptance by the public and no proof of lack of obviousness *at the time the alleged invention was made*, as the Statute requires.

The obvious reason why the Court of Appeals did not mention the alleged "many prior unsuccessful attempts" (11) is that there was no proof of any such attempts, as just demonstrated. The Court of Appeals did not violate any fundamental rules of patent law (13) for the proof failed to establish facts to which the cited law would apply.

The decision of the Court of Appeals is impregnable. It held (App. 5):

> "The bare idea of using a soft sleeve or pipe to convey air, fluids, or other materials is very old and

> has been applied many times. Repeatedly it has been held that the use of known devices in an analogous field is not invention."

There is no invention here by any known standard—ancient, current or modern. There is no invention here whether invention be a question of fact, a question of law, or a question of mixed fact and law.

(3) Did the Court of Appeals err in holding that the standard of what constitutes patentable invention is a legal rather than a factual question?

That issue was not before the Court and was not decided by the Court.

The Court held (p. 5 of the Appendix to the Petition), as follows:

> "The issue is whether, according to applicable legal standards, this is a patentable invention. We hold that it is not."

Petitioner seems not to appreciate the difference between "standard of invention," on the one hand, and "validity" or "patentable invention," on the other hand.

Whether the standard of what constitutes invention is a legal or factual question was not an issue in any of the cases cited by Petitioner (21-23); and was not decided in any of those cases.

Thus the alleged conflict of decisions is non-existent.

But if it be assumed that Petitioner really meant "patentable invention" or "validity" when it said "standard of invention," there is still no conflict shown by the cited cases.

This Court long ago, and recently, has held that patentable invention or validity is a question of law.

In *Mahn v. Harwood*, 112 U. S. 354, 358 this Court held in 1884 as follows:

> "In cases of patents for inventions, a validity defense not given by the Statute often arises where the question is, whether the thing patented amounts to a patentable invention. *This being a question of law* the Courts are not bound by the decision of the Commissioner, although he must necessarily pass on it." (Citing cases).

In *Graver Tank & Mfg. Co., Inc., et al. v. Linde Air Products Co.*, 336 U. S. 271, 275, this Court held, in 1948 as follows:

> "While the ultimate question of patentability is one of meeting the requirements of the statute, R. S. § 4886, as amended, 35 U. S. C. § 31, the facts as found with respect to these four flux claims warrant a conclusion here that as a matter of law those statutory requirements have been met."

and, on page 280, where, in a concurring decision, Mr. Justice Black, with whom Mr. Justice Douglas concurred, said:

> "While accepting the findings of those two courts on what I consider to be questions of fact, it is my view that *determination of the ultimate question of patentability cannot properly be classified as a finding of fact.* I would adhere to this Court's earlier pronouncement that 'whether the thing patented amounts to a patentable invention' is a question of law to be decided by the courts as such."

In *Great Atlantic & Pacific Tea Co. v. Supermarket Corporation*, 340 U. S. 147, 153 this Court held in 1950 as follows:

> "We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter which cannot stand as a matter of law."

and, on page 155, where, in a concurring opinion, Mr. Justice Douglas with whom Mr. Justice Black concurred, said:

"The standard of patentability is a constitutional standard; *and a question of validity of a patent is a question of law.*"

The decisions in five of the seven cases cited (23) held that patentable invention was a question of fact. However, those decisions were handed down before this Court decided the foregoing cases of *Graver v. Linde* and *Great Atlantic & Pacific Tea Co. v. Supermarket*. It is to be presumed that the Courts concerned in those five cases will not go counter to what this Court held in these last two decisions; and we have been unable to find that any of those Courts of Appeals has gone contrary to those decisions of this Court since they were handed down.

In the sixth of those cases, i.e., *Beckton Dickinson & Co. v. R. P. Scherer Corporation*, 211 Fed. (2) 835, the Court of Appeals for the Sixth Circuit had before it an issue of fraud. The question of invalidity "was not seriously contested. * * * the evidence was uncontradicted." (p. 842.)

In the seventh of those cases, i.e., *Texas Co. v. Globe Oil & Refining Co.*, 225 Fed. (2) 725, the Court of Appeals for the Seventh Circuit held that findings on factual issues by a Master and approved by the District Court should be accepted on appeal unless clearly erroneous. While the Court of Appeals for the Seventh Circuit had decided one of those five cases that Court followed—did not go contrary to—the foregoing decisions of this Court. In *Noble Co. v. C. S. Johnson Company*, 241 Fed. (2) 469, 476, that Court held:

"When the district court has thus found the ultimate facts, it is then its duty to decide, as a matter of law, the over-all question of validity, which, of course, is likewise subject to review. In this connection it should be noted that invention does not connote patentability. Galland-Henning Co. v. Loge-

mann Bros. Co., 7 Cir., 142 F. 2d 700, 703, certiorari denied 323 U. S. 767, 65 S. Ct. 120, 89 L. Ed. 614, and Harley C. Loney Co. v. Ravenscroft, 7 Cir., 162 F. 2d 703, 704."

Thus it appears that there is no conflict between Courts of Appeals on the question of whether patentable invention or validity is a question of law since this Court's decisions in cases of *Graver v. Linde* and *Great Atlantic & Pacific Tea Co. v. Supermarket*.

Invention is absent in this case whether invention is a question of law or a question of fact.

All Holtzclaw did was to extend the old idea of using a flexible hose to a new and analogous use.

All Holtzclaw did was to substitute a longer tube of flexible material for a short tube of rigid material. This is not distinguishable from the "extension of the counter" in the *Great Atlantic & Pacific Tea Co. v. Supermarket* case.

There is no invention in either of these acts by any standard, old or new, whether invention is a question of law or a question of fact.

In reality what Petitioner is asking this Court to do is to reverse its decisions in such cases as *Mahn v. Harwood*, *Graver v. Linde* and *Great Atlantic & Pacific Tea Co. v. Supermarket*.

CONCLUSION.

For the reasons set forth above we respectfully submit that the Petition should be denied.

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